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REMARKS

By this amendment, a modified limitation of claim 10 has been moved into claim 1, and claim 10 has been canceled. New claims 11-20 have been added, leaving claims 1-8 and 11-20 now pending in this application, and these are presented to the Examiner for consideration at this time.

Although claim 10 was previously objected to as "merely stating that the components can be located outside an intradiscal space," as part of claim 1, they are, indeed, positively located outside of an intradiscal space, thereby overcoming the objection under 37 CFR §1.75(c). Claim 8 has also been amended to overcome the rejection under 35 U.S.C. §112.

Although claim 10, now forming part of claim 1, was rejected under 35 U.S.C. §102(b) over Cauthen, U.S. Patent No. 6,019,792, it was apparently not examined. The Examiner makes reference to claims 2-7, but claim 10 is not mentioned. In fact, the end cap (90) of Cauthen is not only attached to the implant 10, but it clearly is disposed within an intradiscal space, thereby defeating anticipation. With respect to claim 8, given that Cauthen's spinal implant is essentially a cylindrical dowel-type unit including a ball-and-socket joint, there is no teaching or suggestion from the prior art to utilize allograft material. Despite the teachings of Nicholson et al., it is well settled that it is well-settled that, in rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to combine the cited references to arrive at Applicant's claimed invention. The "Examiner's position" does not set forth the standard. Rather, there must be something *in the prior art* that suggests the proposed combination, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroval Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior-art references. In Re Dembieczak, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

Based upon the foregoing amendments and comments, Applicant believes the subject application is in condition for allowance. Questions regarding this application may be directed to the undersigned attorney by telephone, facsimile or electronic mail.

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